



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 555255012115

Group Art Unit: 2178)
Examiner: Londra C. Burge)
Inventor: Maguire)
Serial No.: 09/624,285)
Filed: 07/24/2000)
For: System and Method for Abbreviating)
Information Sent to a Viewing Device)

APPEAL BRIEF

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited today with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on Sept 22 2004.

By _____

Debbie Bejean

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted in response to the Office Action mailed April 5, 2004, which finally rejected pending claims 22-33 of this application. A timely-filed notice of appeal was submitted on June 4, 2004 and received by the USPTO on June 7, 2004. A petition and fee for a two-month extension of time is included herewith. Any

fees due, including the extension of time fee and the fee due under 1.17(c), should be charged to Jones Day Deposit Account No. 501432, ref: 555255-012115.

1. Real Party in Interest

The real party in interest for this application is Research In Motion, Limited, a Canadian corporation having its principal place of business at 295 Phillip Street, Waterloo, Ontario, Canada, N2L 3W8. The inventor of this application has assigned his rights to Research In Motion, as evidenced by documents recorded with the USPTO on October 23, 2000, at Reel 11196, Frame 0436.

2. Related Appeals and Interferences

There are no related appeals or interferences to this application.

3. Status of Claims

Claims 22-33 remain pending in this application.

4. Status of Amendments

No Amendments have been made to claims 22-33.

5. Summary of Invention

The invention described in claims 22-33 is a method of providing an information page, such as a web page, to a handheld, portable viewing device, such as a PDA, cellular telephone, two-way pager, etc. (2:5-12)¹ This method is aimed at solving two problems: (1) how to provide graphically-laden information pages to handheld devices having limited memory capabilities; and (2) how to enable framed information pages to be viewed and accessed on such devices. (2:14-21)

The first problem is solved by generating an abbreviated version of the information page. (9:17 through 10:2) This abbreviated version includes a graphical representation of the information page. (Id.) The second problem is solved by including an image map along with the graphical representation of the information page, where the image map identifies the locations of the plurality of frames within the graphical representation of the information page. (10:9-15)

After the abbreviated version of the information page and the image map are provided to the handheld viewing device, the user of the device can select a particular frame of the page for more detailed viewing on the device. (10:12-15) This is accomplished by accessing the image map in response to selecting a portion of the graphical representation of the information page to determine the frame that corresponds to the selected portion and then retrieving a graphical representation of just the selected frame for further viewing on the handheld device. (Id.) This process is

¹ (page : line numbers) of specification.

described graphically in Figure 5 of the application, which is set forth below:

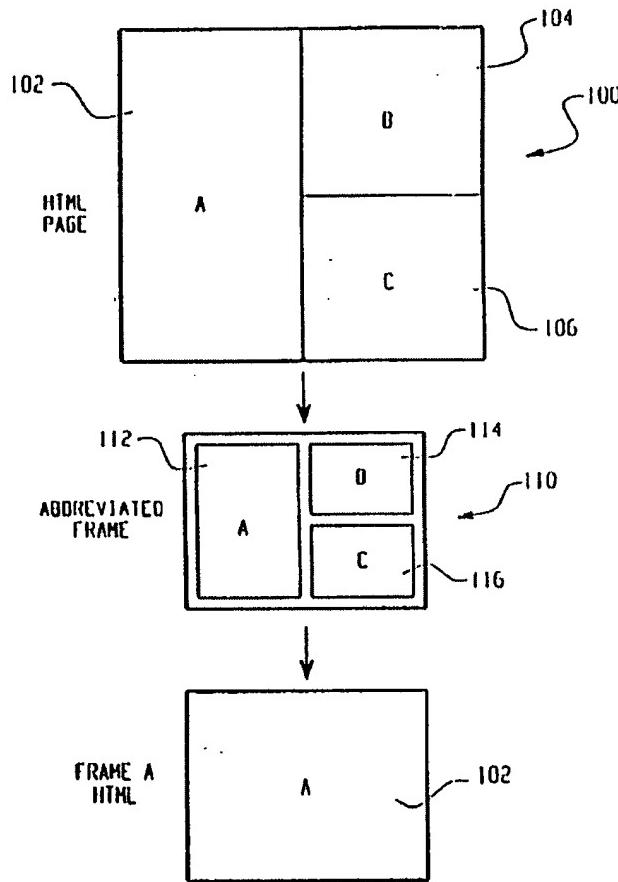


Fig. 5

Figure 5 shows an example framed HTML web page 100 as it would be rendered on a desktop computer system. The page 100 includes three separate frames 102, 104 and 106 where graphics, animations, text and other information can be independently displayed and viewed. (10:16-24) According to the method of claims 22-

33, the page 100 is first converted into an abbreviated version of the page 100, the abbreviated version 110 being a graphical representation of the page 100, such as a bitmap file. (10:9-15) A bitmap file cannot be accessed and manipulated, like the information page 100 can, and therefore additional information must be generated to manipulate the abbreviated version of the information page 100 – that information being the image map data. (Id.) The image map provides a link between the original information page structure and the graphical representation thereof. (Id.) Specifically, the image map defines an area of the graphical representation that corresponds to each of the three separate frames. (Id.) Thus, area 112 corresponds to the A frame, area 114 corresponds to the B frame, and area 116 corresponds to the C frame. The user of the handheld viewing device may then select a portion of the graphical representation, and the image map is then accessed to determine which frame, A, B or C, has been selected for further viewing. (11:1-10)

The invention described in claims 22-33 also provides for a gateway device coupled between the handheld viewing device and a remote system where the information page is stored, wherein the gateway may be a wireless gateway, and wherein the gateway retrieves, stores, and generates the abbreviated version of the information page and the image map, and also responds to requests for additional frames of data from the handheld viewing device. (9:4-15)

6. Issues

The issue on appeal is whether pending claims 22-33 have been properly rejected under 35 USC 103(a) over EP 0949571 to Bickmore ("Bickmore") in view of US 5,479,602 to Baecker ("Baecker").

7. Grouping of Claims

For purposes of this appeal only, Claims 22-28, 31 and 32 stand or fall together with the independent claim 22. Claims 29-30 and 33 do not stand or fall with claim 22 but are argued herein separately. Claims 29-30 stand or fall together and claim 33 stands or falls on its own. As such, applicants provide argument below with respect to claims 22, 29 and 33.

8. Argument

I. Law of Obviousness

In rejecting a claim under 35 USC § 103, the PTO follows the Supreme Court's guidance from *Graham v. John Deere Co.*, 383 US. 1 (1966). In *Graham*, the Supreme Court set forth four factual inquiries as a background for determining obviousness: (1) determining the scope and contents of the prior art; (2) ascertaining the differences between the prior art and the claims in issue; (3) resolving the level of ordinary skill in the pertinent art; and (4) evaluating evidence of secondary considerations. *Graham* at 148. MPEP § 2141. The PTO Examiner's are to apply the *Graham* inquiries in meeting

their burden to demonstrate a *prima facie* case of obviousness under 35 USC § 103.

MPEP § 2142 sets forth the legal concept of the *prima facie* case of obviousness under 35 USC § 103. According to the MPEP, "The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." MPEP § 2142.

To establish the *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art references must teach or suggest all the claim limitations. MPEP § 2142. Importantly, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

II. The Obviousness Rejection of Claim 22 is Improper

The PTO rejected claim 22 as being obvious over Bickmore in view of Baecker. This rejection, however, fails to meet the standards set forth in MPEP §§2141-2142 because the combination of Bickmore and Baecker fails to teach or suggest all of the claim limitations, and also because there has been no showing of either a suggestion or motivation to combine these references.

Independent claim 22 recites a method of providing an information page to a handheld viewing device. The method includes the following steps: (A) requesting an information page at the handheld viewing device; (B) retrieving the information page from a remote system; (C) if the information page includes a plurality of frames, then generating an abbreviated version of the information page, wherein the abbreviated version includes a graphical representation of the information page and an image map that identifies the locations of the plurality of frames within the graphical representation of the information page; and (D) transmitting the abbreviated version of the information page to the handheld viewing device.

Neither of steps (C) or (D) are disclosed or suggested by Bickmore or Baecker and therefore the *prima facie* case of obviousness has not been met by the PTO.

Bickmore teaches that a document is converted into sub-documents containing a portion of the original document:

"This invention separately provides systems and methods that automatically transform a document into a plurality of linked subdocuments, where each subdocument requires less display area."
(Bickmore at 3, ll. 41-42)

"The automatic re-authoring system and method input a document to be re-authored and re-authoring parameters, such as display screen size, default font and the like. The automatic re-authoring system and method convert the document into a number of pages..." (Bickmore, Abstract)

Figure 1 of Bickmore shows the transformation of an original text document, having

headings and associated text, to a re-authored sub-document in which the headings are retained, but the associated text is suppressed. When a user of the Bickmore system selects one of the text headings, the associated text is then retrieved and displayed.

Baecker discloses a system for generating “content-based” depictions of computer icons. In this system, an icon is generated that looks like the document it is representing. In essence, Baecker creates a picture of the document and then scales the picture down to the size of an icon. (Baecker at 3:21-25) In addition, Baecker describes a process where a number of different replicas of the document can be generated and then displayed in an animation sequence. (Baecker at 3:43-46)

A. The Cited References Do Not Disclose an Information Page Having Frames

Claim 22 requires an information page that includes a plurality of “frames.” In this context the word “frame” is used as it would be to define a framed web page, although the claims are broader than web pages and may encompass other types of information pages. In the context of a web page, the term frame is defined as “A rectangular section of the page displayed by a Web browser that is a separate HTML document from the rest of the page. Web pages can have multiple frames, each of which is a separate document.” (Microsoft Computer Dictionary, Third Edition, 1997, at page 207)

Neither of the cited references (Bickmore or Baecker) disclose framed information pages. The Examiner points to Figure 2 of Bickmore for the alleged teaching of this limitation, but that figure does not show a “framed” information page –

i.e., a page that includes rectangular sub-pages that are separate documents – it shows a table. (See, Bickmore at 4:35-36, “Fig. 2 illustrates a layout table. . .”) In fact, nowhere in the entire disclosure of the Bickmore reference is the word “frame” even used. A table is not a “framed” information page as that term is used in the present application, and as the term is commonly known to those skilled in the art as evidenced by the above-quoted dictionary, and thus the rejection fails to meet the requirements set forth in the MPEP for establishing the *prima facie* case of obviousness.

B. The Cited References Do Not Disclose an Abbreviated Version of the Information Page

Claim 22 recites the step of “generating an abbreviated version of the information page, wherein the abbreviated version includes a graphical representation of the information page and an image map the identifies the locations of the plurality of frames within the graphical representation...” Neither of the cited references disclose or suggest such an abbreviated version of the information page.

Addressing Bickmore first, the Examiner concedes that this reference does not teach a graphical representation of the information page. But, somehow, the Examiner concludes that it shows an image map as claimed. This is clearly not the case. The claimed purpose of the image map is to “identify the locations of the plurality of frames within the graphical representation.” Bickmore doesn’t even show frames, and therefore couldn’t possibly teach such an image map. And, the portion of the reference relied upon to show the claimed “image map” – Bickmore paragraph 131 – doesn’t use

the words “image” or “map,” and clearly has nothing to do with identifying locations of frames in a graphical representation of an information page. The impossibility of Bickmore teaching the claimed “image map” is evidenced by the fact that it doesn’t teach frames or graphical representations of information pages, and therefore couldn’t possibly teach or suggest something that identifies the locations of frames within a graphical representation of an information page.

Baecker does not disclose or suggest the claimed “abbreviated version” of the information page either. The Examiner makes no attempt to show “framed information pages” or even an “image map” anywhere in the Baecker reference – as they are clearly not shown there, but merely states that Baecker shows the graphical representation of a file (an icon) and seems to be stating that Baecker shows where the files are located. These facts, however, are irrelevant to the claimed subject matter. Baecker, like Bickmore, has nothing to do with “framed” information pages. Thus, there can be no concept of the claimed “image map” in Baecker, because its’ sole claimed purpose is to identify the locations of the framed portions of the information page in the graphical representation thereof.

For this additional reason, the rejection fails to meet the requirements set forth in the MPEP for establishing the *prima facie* case of obviousness.

C. The Cited References Do Not Transmit an Abbreviated Version of the Information Page to a Handheld Device

Claim 22 also requires that the abbreviated version of the information page,

which includes the graphical representation and the image map, is transmitted to the Handheld Viewing Device. Neither Bickmore or Baecker teaches this step. The Examiner relies on Paragraph 77 of Bickmore for this teaching, but this paragraph is silent with respect to the transmission of either a graphical representation of an information page or an image map. Rather, paragraph 77 describes a process of transmitting a re-authored document to a wireless device. The re-authored document is an abbreviated version of an original document, in that it includes less text, but there is nothing in paragraph 77 that describes the transmission of a graphical representation of the information page – which it couldn't as the Examiner has conceded that Bickmore does not teach graphical representation – or of the transmission of an image map – which as described above is not shown in Bickmore.

For this additional reason, the rejection fails to meet the requirements set forth in the MPEP for establishing the *prima facie* case of obviousness.

D. The Final Office Action Fails to Make a Showing of any Motivation to Combine Bickmore and Baecker

Finally, the obviousness rejection over Bickmore in view of Baecker fails because the Examiner has failed to show the first requirement of the *prima facie* case of obviousness: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings (MPEP § 2142).

In rejecting claim 22, the Examiner states “It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply Baecker to Bickmore; providing Bickmore the benefit of displaying the static reduced visual versions in a serial sequence at said location on the display screen as taught by Baecker Col 10 Lines 55-56). Frankly, it is not clear what this reasoning has to do with the claimed invention. As pointed out above, neither reference teaches “framed” information pages, neither reference teaches the claimed “image map,” and neither reference teaches the transmission of a graphical representation of an information page. The alleged “motivation” pointed to by the Examiner appears to be disjoint from the claimed subject matter, and thus irrelevant to the question of whether one of skill in the art would be motivated to combine Baecker with Bickmore in order to arrive at the subject matter of claim 22.

For this additional reason, the rejection fails to meet the requirements set forth in the MPEP for establishing the *prima facie* case of obviousness.

II. The Obviousness Rejection of Claim 29 is Improper

Claim 29 depends from claim 22, and adds the following additional steps: (A) displaying the graphical representation of the information page at the handheld viewing device; (B) selecting a portion of the graphical representation; (C) accessing the image map to determine a frame that corresponds to the portion of the graphical representation selected; and (D) retrieving a graphical representation of the selected

frame and displaying it on the handheld viewing device.

The Examiner rejected claim 29 under section 103 over Bickmore in view of Baecker, finding that Bickmore teaches all of the claimed steps with the exception of the “graphical representation” part of the claim, which is allegedly found in Baecker. Once again, however, the Examiner has failed to appreciated the meaning of the term “frame” to one of skill in the art, and the requirement that the “image map” is linked to the graphical representation of the information page. Without these teachings, as noted above with respect to claim 22, it is not possible for Bickmore to provide the claimed steps in claim 29.

In fact, Bickmore teaches none of the steps in claim 29. Regarding the first step, Bickmore does not teach a graphical representation of the information page. Regarding the second step, Bickmore does not teach selecting a portion of the graphical representation. Regarding the third step, Bickmore does not teach an image map at all, let alone a map that is used to determine a frame within the graphical representation of the information page. And regarding the fourth step, Bickmore does not teach a graphical representation of a selected frame.

For all of these reasons, the *prima facie* case of obviousness with respect to claim 29 has not been met and therefore the rejection is improper.

III. The Obviousness Rejection of Claim 33 is Improper

Claim 33 depends from claim 22 and adds the step of “reducing the size of the graphical representation of the information page to match the display characteristics of

the handheld viewing device," before transmitting the graphical representation to the viewing device. This step is clearly not shown in Bickmore. The Examiner points to Paragraph 90, line 14 and paragraph 77, lines 42-43 along with Figure 5 as allegedly showing this step. None of these portions of Bickmore, however, relate to reducing the size of a graphic to match the display characteristics of a handheld device.

Paragraph 90, line 14 states ". . . document before any re-authoring. In this state 0, the transformed abstract syntax tree portion stores the original un..." Paragraph 77, lines 42-43 state ". . . document to the limited display area device 510 over one of the wireless communication channel 530 or the communication link 522." And the description of Figure 5 says that it provides 25% image reduction. None of these descriptions, however, teach the step of reducing the size of the graphical representation of the information page to match the display characteristics of the handheld viewing device.

For all of these reasons, the *prima facie* case of obviousness with respect to claim 33 has not been met and therefore the rejection is improper.

9. Appendix

Following this page is an appendix setting forth a copy of the pending claims in this application.

Respectfully submitted,

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APPENDIX A

22. A method of providing an information page to a handheld viewing device, comprising the steps of:
- requesting an information page at the handheld viewing device;
 - retrieving the information page from a remote system;
 - if the information page includes a plurality of frames, then generating an abbreviated version of the information page, wherein the abbreviated version includes a graphical representation of the information page and an image map that identifies the locations of the plurality of frames within the graphical representation of the information page; and
 - transmitting the abbreviated version of the information page to the handheld viewing device.
23. The method of claim 22, further comprising the steps of:
- providing a gateway device for receiving the request from the handheld viewing device and for retrieving the information page from the remote system.
24. The method of claim 23, further comprising the steps of:
- coupling the gateway device to the handheld viewing device via a wireless network.

25. The method of claim 23, further comprising the steps of:
 - coupling the gateway device to the remote system via a wired network.
26. The method of claim 25, wherein the wired network is the Internet, and the remote system is a world-wide-web server.
27. The method of claim 26, wherein the information page is a web page.
28. The method of claim 23, wherein the gateway device stores the information page in a cache and generates the abbreviated version thereof, including the graphical representation and the image map.
29. The method of claim 22, further comprising the steps of:
 - displaying the graphical representation of the information page at the handheld viewing device;
 - selecting a portion of the graphical representation;
 - accessing the image map to determine a frame that corresponds to the portion of the graphical representation selected; and
 - retrieving a graphical representation of the selected frame and displaying it on the handheld viewing device.

30. The method of claim 29, further comprising the steps of:

providing a uniform resource locator (URL) associated with each of the plurality of frames identified by the image map; and
transmitting one of the uniform resource locators to the remote system in response to selecting the portion of the graphical representation.

31. The method of claim 22, wherein the graphical representation is a bitmap file.

32. The method of claim 22, further comprising the steps of:

if the information page does not include a plurality of frames, then transmitting the information page to the handheld viewing device without abbreviating it into the graphical representation and the image map.

33. The method of claim 22, further comprising the steps of:

prior to the transmitting step, reducing the size of the graphical representation of the information page to match the display characteristics of the handheld viewing device.